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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/060,409	04/14/98	SAH	D 860098.420

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HM22/0720

EXAMINER

BAKER, A

ART UNIT	PAPER NUMBER
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1632

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DATE MAILED:

07/20/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/060,409

Applicant(s)
Sah et al.

Examiner
Anne-Marie Baker, Ph.D.

Group Art Unit
1632



- ☐ Responsive to communication(s) filed on _____.
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 1 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

- ☒ Claim(s) 1-46 is/are pending in the application.
- Of the above, claim(s) _____ is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☐ Claim(s) _____ is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☒ Claims 1-46 are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
- ☐ received.
- ☐ received in Application No. (Series Code/Serial Number) _____.
- ☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

- ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- ☐ Notice of References Cited, PTO-892
- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____
- ☐ Interview Summary, PTO-413
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Notice of Informal Patent Application, PTO-152

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

Art Unit:

DETAILED ACTION

Claims 1-46 are pending in the instant application.

Election/Restriction

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-5 and 17-46, drawn to a method for producing a conditionally-immortalized rat neural crest stem cell, a cell produced by the method, a conditionally-immortalized PNS progenitor cell, and methods for using the immortalized cells of the invention, classified in class 435, subclass 325.
- II. Claims 6-39 drawn to a method for producing a conditionally-immortalized dorsal root ganglion progenitor cell, cells produced by the method, and methods for using the immortalized cells of the invention, classified in class 435, subclass 325.

Claims 17-39 embrace the inventions of Group I and II and will therefore be examined with either one of Group I or II only to the extent that they encompass the elected subject matter.

The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are patentably distinct because the inventions are drawn to materially different compositions and processes that require the use of different starting materials. The invention of Group I involves the conditional immortalization of rat neural crest stem cells, whereas the invention of Group II involves the conditional immortalization of dorsal root ganglion progenitor cells (either rat or human). The inventions are patentably distinct because the cell types are not obvious variants over each other and each cell

Art Unit:

type would therefore be expected to have a different use and different effect or function. The inventions of Groups I and II require non-coextensive areas of search and consideration because the invention of Group I is limited to producing and using immortalized rat neural crest stem cells and the invention of Group II is limited to producing and using immortalized dorsal root ganglion progenitor cells. Thus, the compositions and methods of the inventions of Groups I and II are patentably distinct.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification and recognized divergent subject matter and because the searches required for the separate inventions are not coextensive, restriction for examination purposes as indicated is proper.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anne-Marie Baker whose telephone number is (703) 306-9155. The examiner can normally be reached Monday through Thursday and alternate Fridays from 9:00 AM to 6:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jasmine Chambers, can be reached on (703) 308-2035. The fax phone number for the organization where this application or proceeding is assigned is (703) 308-8724.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.

Anne-Marie Baker, Ph.D.

Scott D. Pribe
SCOTT D. PRIEBE, PH.D.
PRIMARY EXAMINER